



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/588,515	06/06/2000	John M. Payne	B-65866-CON	9901

20594 7590 09/03/2003

CHRISTOPHER J. ROURK
AKIN, GUMP, STRAUSS, HAUER & FELD, L.L.P.
P O BOX 688
DALLAS, TX 75313-0688

EXAMINER

NGUYEN, PHUOC H

ART UNIT	PAPER NUMBER
----------	--------------

2143

DATE MAILED: 09/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

4

Office Action Summary

Application No.

09/588,515

Applicant(s)

PAYNE ET AL.

Examiner

Phuoc H. Nguyen

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-28 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 13-28 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____

Art Unit: 2143

DETAILED ACTION***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 13-28 are rejected under the judicially created doctrine of double patenting as being unpatentable over claims 1-12 of U.S. Patent 6,167,426.

3. Regarding to claims 13, and 14 (09/588,515), claim 1 of U.S. Patent 6,167,426 recite all limitations in claim 13, and 14 (09/588,515) [see Col. 5, lines 39 through col. 6, lines 15]. The claimed invention in the instant application is fully disclosed in the patent and it is ***broader*** than the claimed invention in the patent. No new invention, or new improvement is being claimed in the instant application. Applications are now attempting to ***claim broadly that which had been previously described in more detail in the claims of the patent (In re Van Ornum, 214 USPQ 761 CCPA 1982).***

Claim 13 (09/588,515) in the instant application simply omits the term **automatically** with respect to claim 1 of U.S. Patent 6,167,426, wherein U.S. Patent 6,167,426 stated that "in response to the designation of said registered name, **automatically** broadcasting a message over the second communication network to the registered address associated with the selected name,

Art Unit: 2143

said message identifying an interactive activity to be conducted over the first communication network.”

Furthermore, there is no apparent reason why applicants was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent.

4. Regarding to claims 18-28 (09/588,515) are equivalent to claims 2-12 of U.S. Patent 6,167,426.

5. Regarding to claims 15-16 (09/588,515), claims 15-16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4, and 8 of U.S. Patent 6,167,426. Although the conflicting claims are not identical, they are not patentably distinct from each other because modifications are obvious.

Regarding to claims 15-16 (09/588,515), claims 4, and 8 of U.S. Patent 6,167,426 recite all limitations in claims 15-16 (09/588,515) [see Col. 5, lines (21-23, and 33-35)]. Claims 4, and 8 of U.S. Patent 6,167,426 do not contains “user prompt includes an audio and video prompt.” However, it would have been obvious in the art at the time of the invention to apply the audio and video prompts to conveniently and automatically interact between the first and the second communication networks.

6. Claims 17 are rejected under the judicially created doctrine of double patenting as being unpatentable over claim 1 of U.S. Patent 6,167,426.

Conclusion


Art Unit: 2143

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuoc H. Nguyen whose telephone number is 703-305-5315. The examiner can normally be reached on Mon -Thu (7AM-4:30PM) and off every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on 703-308-5221. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Phuoc H. Nguyen
Examiner
Art Unit 2143


DAVID WILEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100